



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Carroll et al.	Art Unit: 2878
Serial No: 09/782,089	Examiner: Daniel St Cyr
Filing Date: February 12, 2001	
Title: <i>Automated Reactor Endpointing of Platy Interference Effect Pigment</i>	Atty. Docket No.: 4629

APPEAL BRIEF

Commissioner of Patents
and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal from the Final Rejection dated January 25, 2005.

REAL PARTY IN INTEREST

The real party in interest of this application is Engelhard Corporation.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

06/13/2005 NAME1 00000048 502156 09782089
01 FC:2402 80.00 DA 170.00 OP

09/15/2005 SDIRETA1 00000014 09782089
01 FC:2401 250.00 OP

Repln. Ref: 09/15/2005 SDIRETA1 0010160800
DAH:502156 Name/Number:09782089
FC: 9204 \$80.00 CR

Repln. Ref: 09/15/2005 SDIRETA1 0010163400
DAH:502156 Name/Number:09782089
FC: 9204 \$170.00 CR

Adjustment date: 09/15/2005 SDIRETA1
09/07/2005 DLINDSEY 00000001 09782089
01 FC:1402 -500.00 OP

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July 25, 2005

Refund Branch
U.S. Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

Re: Serial No. 09/782,089
*Automated Reactor Endpointing of
Platy Interference Effect Pigments*
Our Ref: ENG 03-20

To Whom It May Concern:

We would like to be refunded \$250 of which \$80 was charged to Deposit Account No. 502156 of the undersigned attorney and \$170 was paid for by check, for the filing of an Appeal Brief in the above identified application on June 9, 2005.

An Appeal Brief was filed on June 9, 2005 with a check for \$170. A copy of the stamped receipt is enclosed. This Appeal Brief was the second Appeal Brief filed in the above application. A first Appeal Brief was filed on October 16, 2003, a copy of the Certificate of Mailing for filing the Appeal Brief on October 16, 2003 is enclosed. On August 12, 2004 the Patent Office Examiner re-opened prosecution. A copy of 3 pages from the Office Action dated August 12, 2004 is enclosed. In as much as the Examiner re-opened prosecution, the second Appeal Brief filed June 9, 2005 was eventually required to obtain allowance of the application.

In addition to the \$170 check mailed with the Appeal Brief on June 9, 2005, the Patent Office deducted \$80.00 from Deposit Account No. 502156. A copy of the Monthly Statement of Deposit Account for June, 2005 is enclosed.

MPEP, section 1208.03 states "if prosecution was re-opened prior to a decision on the merits by the Board of Patent Appeals and Interferences, the fee paid for the Notice of Appeal, Appeal Brief, and Request for Oral Hearing, (if applicable) will be applied to a later appeal on the same application."

Applicants did not pay a fee for filing the second Notice of Appeal or for a Request for Oral Hearing. Applicants did however submit a fee of \$170 to cover the difference between old and new fees for filing the second Appeal Brief. The undersigned attorney has been advised by

Art Unit 2876 that the MPEP section 1208.03 requires that all fees paid for the filing of the second Appeal Brief should be refunded in as much as the Patent Office re-opened examination prior to a decision by the Board of Patent Appeals and Interferences.

Accordingly, the undersigned attorney requests a refund of \$250 which can be applied to Deposit Account number 502156.

705 JUL 26 2006
US PATENT & TRADEMARK
OFFICE

Respectfully Submitted,

July 25, 2006
Date

Stuart D. Frenkel

Stuart D. Frenkel
Regulation No. 29,500

Enclosure
SDF/amp



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PAID

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,089	02/12/2001	James B. Carroll JR.	US PAT 1629	9721
2352	7590	08/12/2004		
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
			EXAMINER	
			ST CYR, DANIEL	
		ART UNIT	PAPER NUMBER	
		2876		

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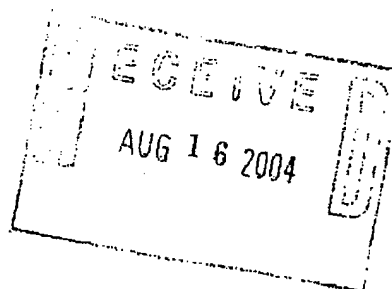
DATE MAILED: 08/12/2004

docketed 11/12/04

Please find below and/or attached an Office communication concerning this application or proceeding.

AUG 26 2004

*Transfer
DSMO*



Docketed	<i>8/26/04</i>	by	<i>pg</i>
Response due	<i>11/12/04</i>		
	<i>Benjamin O.A.</i>		
Attorney	<i>MAR</i>		

Office Action Summary

Application No.

09/782,089

PAID

Applicant(s)

CARROLL ET AL.

Examiner

Daniel St Cyr 205 JUNE 2004

Art Unit

2676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. In view of the Appeal filed on 1/29/04, PROSECUTION IS HEREBY REOPENED. The Office action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.



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LAW OFFICE OF STUART D. FRENKEL, P.C.
3975 UNIVERSITY DRIVE, STE 330
FAIRFAX VA 22030

FINA

US PATENT	Account No.
OFFICE	502156
Date	6-30-05
Page	1

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37 CFR 1.193(a)(2) would authorize a rejection of claim 4 (or amended claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference C, provided the applicant was advised that this rejection would be applied to claim 4 (or amended claim 1). If, however, an amendment under 37 CFR 1.116 proposes to combine the limitations of claims 1, 2, and 3 together into new claim 4 (or add the limitations of claims 2 and 3 to claim 1), 37 CFR 1.193(a)(2) would not authorize a rejection of claim 4 (or amended claim 1) under 35 U.S.C. 103 on the basis of Reference A in view of Reference B and Reference C, even if the applicant is advised that this rejection would be applied to claim 4 (or amended claim 1). Of course, as a claim including the limitations of both claim 2 and claim 3 is a newly proposed claim in the application raising a new issue (*i.e.*, a new ground of rejection), such an amendment under 37 CFR 1.116 may properly be refused entry as raising new issues.

It must be emphasized that amended 37 CFR 1.193(a)(2) does not change the existing practice with respect to amendment after final rejection practice (37 CFR 1.116). The fact that 37 CFR 1.193(a)(2) would authorize the rejection in an examiner's answer of a claim sought to be added or amended in an amendment under 37 CFR 1.116 has no effect on whether the amendment under 37 CFR 1.116 is entitled to entry. The provisions of 37 CFR 1.116 control whether an amendment under 37 CFR 1.116 is entitled to entry; the provisions of 37 CFR 1.193(a)(2) control the rejections to which a claim added or amended in an amendment under 37 CFR 1.116 may be subject in an examiner's answer.

A new prior art reference cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). However, where a newly cited reference is added merely as evidence of the prior well known statement made by the examiner, the citation of the reference in the examiner's answer would not consti-

tute a new ground of rejection within the meaning of 37 CFR 1.192(a)(2). See also MPEP § 2144.03.

Any allegation that an examiner's answer contains an impermissible new ground of rejection is waived if not timely (37 CFR 1.181(f)) raised by way of a petition under 37 CFR 1.181(a).

1208.02 Reopening of Prosecution After Appeal

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a).

Form paragraph 12.81 may be used when reopening prosecution:

¶ 12.81 Reopening of Prosecution - New Ground of Rejection After Appeal or Examiner's Rebuttal of Reply Brief

In view of the [1] filed on [2], PROSECUTION IS HEREBY REOPENED. [3] set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Examiner Note:

1. Use this form paragraph to reopen prosecution in order to make a new ground of rejection of claims or to enter a rebuttal to the reply brief. The finality or non-finality of an Office action following a reopening of prosecution depends on whether the action could have been properly made final had it been entered prior to the appeal.
2. In bracket 1, insert --appeal brief--, --supplemental appeal brief--, --reply brief-- or --supplemental reply brief--.
3. In bracket 2, insert the date on which the brief was filed.
4. In bracket 3, insert --A new ground of rejection is--, --New grounds of rejection are-- or --A rebuttal to the Reply Brief is--.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)

Applicant(s): Carroll et al.

Docket No.

4629

Serial No.

09/782,089

Filing Date

February 12, 2001

Examiner

Daniel St Cyr

Group Art Unit

2878

Invention: Automated Reactor Endpoint of Platy Interference Effect Pigment

I hereby certify that this Appeal Brief

(Identify type of correspondence)

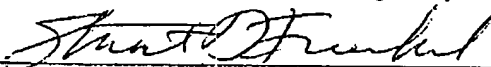
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(Date)

Stuart D. Frenkel

(Typed or Printed Name of Person Mailing Correspondence)



(Signature of Person Mailing Correspondence)

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US Serial No. 09/782,089
Filed: February 12, 2001

Carroll et al.
Entitled: Automated Reactor Endpointing of Platy Interference Effect Pigment

Transmittal of Appeal Brief
Appeal Brief (in triplicate)
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4629 ENG 03-20

June 9, 2005



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